

## REMARKS

In an Office Action dated May 17, 2005, (1) the drawings were objected to for being unclear; (2) the specification was objected to for failing to label trademarks and for including operable hyperlinks; (3) Claim 1 was rejected for grammatical errors; (4) Claims 1-4 were rejected for being indefinite; (5) Claim 4 was rejected as being directed toward non-statutory subject matter; (6) Claims 1-4 were rejected as being anticipated by Presnell (U.S. Patent No. 6,182, 067); (7) Claims 1-4 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting; and (8) Claims 1-4 were provisionally rejected for double patenting. By way of this Amendment, Applicant hereby amends Claims 1 and 2; cancels Claim 3; presents new Claims 5-41; and reserves the right to pursue all previously presented claims in un-amended form in any related application, including, without limitation, any divisional, continuation, continuation-in-part, re-examination, or reissue application. Pursuant to 37 C.F.R. 1.111, Applicant respectfully requests reconsideration of the application.

## DRAWING OBJECTIONS

The drawings stand objected to for not being of a quality that can be understood and reproduced. The Applicant's attorney does not fully understand the bases for the Examiner's objection. The Examiner is respectfully requested to clarify with specificity the manner in which the drawings should be amended to warrant withdrawal of this objection.

## SPECIFICATION OBJECTIONS

The Examiner objected to (1) including trademarks without appropriate recognition and (2) to including browser executable code in the specification. In response to the trademark objections, Applicant hereby amends the specification to include a trademark designation for the following: Reuters, Google, Lexis, Intel, Microsoft, .NET, Windows, Explorer, Word, Mac, Sun J2EE, Exchange, Active Directory, Outlook, Outlook Express, Corbis, and Getty Images.

25315

CUSTOMER NUMBER

-13-

NERV-1-1006ROA1-FINAL

BLACK LOWE & GRAHAM PLLC

701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

In response to the browser executable code, Applicant hereby amends the Specification to include brackets around each instance of “http” and “www” in a hyperlink (i.e. [http://www].domainname.com), thereby disabling any browser executable code. Although the links are disabled, Applicant hereby maintains any incorporation by reference of the content of the previously enabled links.

A Replacement Specification that incorporates the trademark designations and the disabled hyperlinks is provided. No new matter was added.

#### **GRAMMATICAL ERRORS**

The Examiner correctly objected to Claim 1 as being grammatically incorrect for using the phrase “semantic ascertaining.” It should have read: “semantically ascertaining”. Nevertheless, Applicant has amended Claim 1 and respectfully submits that the amendment moots the objection. Applicant reserves the right to pursue the previously presented claim in any related application.

#### **SECTION 112, SECOND PARAGRAPH REJECTIONS**

The Examiner rejected Claims 1-4 under 35 U.S.C. 112, second paragraph as being indefinite. Applicant hereby amends Claims 1 and 2, cancels Claim 3, and respectfully traverses. First, Applicant submits that the amendments to Claims 1 and 2 overcome this rejection. Second, Applicant submits that Claim 4 is not indefinite. Claim 4 is directed to a method for use on a server that is programmed to maintain and host domain specific information that is used to categorize information. The method includes securing information from sources, linking the information, maintaining the information, delivering the information based on user queries, and presenting the information. If the Examiner maintains that Claim 4 is indefinite, Applicant respectfully requests that the Examiner indicate the aspects of Claim 4 that are unclear. Applicant reserves the right to pursue the previously presented claims in any related application.

25315

CUSTOMER NUMBER

-14-

NERV-1-1006ROA1-FINAL

BLACK LOWE & GRAHAM PLLC

701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

## SECTION 101 REJECTION

The Examiner rejected Claim 4 under 35 U.S.C. 101 for being directed towards non-statutory subject matter. Applicant submits that Claim 4 is not directed towards non-statutory subject matter. Under 35 U.S.C. 101, “Whoever invents or discovers any new and useful process ... may obtain a patent therefor....” Claim 4 is directed to a new and useful process for use on a server that is programmed to maintain and host domain specific information that is used to categorize information. The process includes securing information from sources, linking the information, maintaining the information, delivering the information based on user queries, and presenting the information. Accordingly, Applicant submits that the process of Claim 4 falls within the scope of 35 U.S.C. 101 and is patentable subject matter.

## SECTION 102 REJECTIONS

The Examiner rejected Claims 1-4 under 35 U.S.C. 102(e) as being anticipated by Presnell. Applicant hereby amends Claims 1 and 2, cancels Claim 3, and traverses. Applicant reserves the right to pursue the previously presented claims in any related application.

Under 35 USC 102, every limitation of a claim must *identically* appear in a single prior art reference for it to anticipate the claim. *See Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). There must be *no difference* between the claimed invention and the reference disclosure. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). Anticipation can be found only when the reference discloses *exactly* what is claimed. *See Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985).

**In regards to Claims 1 and 4, Presnell does not teach or fairly suggest determining at least one semantic relationship between information and at least one category using domain-specific data. Indeed, Presnell goes to great lengths to intricately describe keyword searches, rather than determining at least one semantic relationship between information and at least one category and delivering information based on the at least one**

25315

CUSTOMER NUMBER

-15-

NERV-1-1006ROA1-FINAL

BLACK LOWE & GRAHAM PLLC

701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

*semantic relationship.* First, “[a] user is *required* to enter ... *terms 104, such as words or phrases ... expressions.*” (Col. 8, Line 32). After the keyword search string is defined, “The user then has the option 107 of specifying particular locations within a document to be searched, such as title, abstract, and/or body, *for the applicable terms.*” (Col. 8, Line 32). The keyword query is then submitted and the “presence of *any of the concept terms* in the title, abstract, or body of a document indicates that the document is *likely to relate to the user's definition* of the concept....” (Col. 9, Line 9). The documents containing these keywords are then collected and simply “saved 252 in the nominated Information Bank 253 for later use.” (Col. 13, Line 3). Finally, the delivery component of the system is responsible for indiscriminately “delivering them in electronic form to those people who have a nominated interest.”

***A priori, Presnell does not teach or fairly suggest delivering information based on at least one semantic relationship between information and at least one category.*** Given that Presnell *does not teach determining any semantic relationships between information and any categories* using domain-specific data (as discussed immediately above), *it cannot teach delivering information based on at least one semantic relationship between information and at least one category* because no semantic relationships have been determined in the first place. Instead of delivering information based on relationships, Presnell teaches a system for retrieving documents based on *keyword searches* and indiscriminately delivering those documents via email or newsletters. Presnell requires that a user first create a list of keywords or phrases. These keywords or phrases are submitted to a keyword search engine that returns documents that contain those keywords or phrases. These documents are stored and periodically distributed.

***The failure of Presnell to teach or fairly suggest determining at least one semantic relationship between information and a category and delivering information based on the at least one semantic relationship results in at least two major deficiencies.*** First, Presnell is unable to accept a *relationship* search and deliver information thereon. Second, Presnell, and keyword searches in general, suffer from semantic indeterminacy. Unlike numbers, documents

25315

CUSTOMER NUMBER

-16-

NERV-1-1006ROA1-FINAL

BLACK LOWE & GRAHAM PLLC

701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

on a particular subject can be represented in an almost unlimited number of ways. As an example, suppose an inquirer wanted a document addressing the “techniques of records management.” The following keywords and phrases would each accurately describe techniques of records management: records management systems, records organization, records organizing systems, file management, techniques of file management, file management systems, systems of file management, filing systems, filing methods, methods of filing, methods of file management, techniques of file organization, file organization methods, information systems, techniques of information system design, office systems, office information systems. The consequence of this phenomenon is that it becomes increasingly *problematic for an inquirer to guess the description* that will most likely produce the desired results. Yet, *Presnell, and keyword searches in general, embrace semantic indeterminacy by placing the burden on the inquirer to guess the description* that will most likely produce the desired results.

Accordingly, Applicant submits that Claim 1 and its dependent claims, including Claim 2, and Claim 4 are allowable because Presnell does not teach or fairly suggest determining at least one semantic relationship between information and at least one category using domain-specific data or delivering information based on at least one semantic relationship between information and at least one category.

#### **PROVISIONAL NON-STATUTORY DOUBLE PATENTING REJECTIONS**

The Examiner provisionally rejected Claims 1-4 under the judicially created doctrine of obvious-type double patenting over claims present in co-pending Application No. 10/179,651. Applicant hereby amends Claims 1 and 2, cancels Claim 3, and traverses. Applicant reserves the right to pursue the previously presented claims in any related application.

Applicant amended the claims of Application No. 10/179,651 in a Response to an Office Action for the same application dated May 19, 2005. At least because of the amendments to the

25315

CUSTOMER NUMBER

-17-

NERV-1-1006ROA1-FINAL

BLACK LOWE & GRAHAM PLLC

701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

claims of Application No. 10/179,651 and the amendments to Claims 1 and 2 of the present application, Applicant submits that Claims 1, 2, and 4 of the present application are not obvious over any of the claims in Application No. 10/179,651 and requests reconsideration.

#### **PROVISIONAL STATUTORY DOUBLE PATENTING REJECTIONS**

The Examiner provisionally rejected Claims 1-4 under 35 U.S.C. 101 for claiming the same invention as that of various claims of Application No. 10/179,651. Applicant hereby amends Claims 1 and 2, cancels Claim 3, and traverses. Applicant reserves the right to pursue the previously presented claims in any related application.

A rejection under 35 U.S.C. 101 for double patenting is permitted only when two patents claim *identical* subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be *literally* infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. MPEP 804.

Applicant amended the claims of Application No. 10/179,651 in a Response to an Office Action for the same application dated May 19, 2005. At least because of the amendments to the claims of Application No. 10/179,651 and Claims 1 and 2 of the present application, Applicant submits that Claims 1, 2, and 4 are *not identical* to any of the claims in Application No. 10/179,651 and requests reconsideration.

25315

CUSTOMER NUMBER

-18-

NERV-1-1006ROA1-FINAL

BLACK LOWE & GRAHAM PLLC

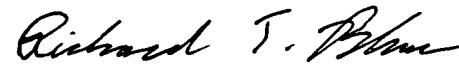
701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301

## CONCLUSION

The Examiner is kindly thanked for his attention to the present patent application. Applicant invites the Examiner to a demonstration of various embodiments of the present invention. The Applicant respectfully requests early passage of the claims to issuance. If the Examiner has any questions, he is invited to contact the Applicants' attorney listed below. **If the Examiner does not agree that all claims in the application are now in condition for allowance, the Examiner is respectfully requested to contact the undersigned to arrange a discussion of the application with the undersigned prior to issuing an Office Action on the merits in this case.**

Respectfully submitted,

BLACK LOWE & GRAHAM<sup>PLLC</sup>



Richard T. Black, Esq.  
Registration No. 40,514  
Direct Dial: 206.381.3302

## EXPRESS MAIL CERTIFICATE

I hereby certify that this communication is being deposited with the United States Postal Service via Express Mail No. **EV509172514US** under 37 C.F.R. § 1.10 on the date indicated below addressed to: MAIL STOP PROVISIONAL PATENT APPLICATION, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

November 17, 2005  
Date of Deposit

  
Myla Kent

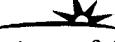
25315

CUSTOMER NUMBER

-19-

NERV-1-1006ROA1-FINAL

BLACK LOWE & GRAHAM<sup>PLLC</sup>



701 Fifth Avenue, Suite 4800  
Seattle, Washington 98104  
206.381.3300 • F: 206.381.3301